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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Sivasubramaniam, et al.

Application No.: 10/666,348

Filed: September 18, 2003

For: APPARATUS FOR
INDUCTION HEATING AND
METHOD OF MAKING

Examiner: Van, Quang T.

Group Art Unit: 3742

Confirmation No.: 8185

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In the Office action dated October 28, 2004, claims 1-37 were indicated as pending and were subject to a restriction requirement. The Examiner indicated that the subject application contains claims directed to the following patentably distinct species of the claimed invention: Species I (Figure 1), Species II (Figure 2) and Species III (Figure 3). The Examiner further required the Applicant to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held allowable. Currently, claims 1-2 and 20-21 are considered by the Examiner to be generic.

Applicant traverses the restriction requirement for at least the following reasons. In accordance with MPEP § 806.04(f), claims that are to be restricted to different species must be mutually exclusive. The general test as to when the

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claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, **while** a second claim recites limitations disclosed only for the second species and not the first.

By grouping the claims as indicated (i.e., claims associated with Figure 1 as Species I, Figure 2 as Species II, and Figure 3 as Species III), the Examiner is suggesting that the claims associated with Figure 1 are mutually exclusive with the claims associated with either of Figures 2 and 3, the claims associated with Figure 2 are mutually exclusive with the claims associated with either of Figures 1 and 3, and the claims associated with Figure 3 are mutually exclusive with the claims associated with either of Figures 1 and 2.

Applicant respectfully disagrees with this characterization. In particular, Applicant submits that claims 1-8 and 20-25 are generic in that elements of each of these claims are shown in each of Figures 1-3. Additionally, Applicant submits that although claims 11-12 and 28-29 may not be generic, they likewise are not mutually exclusive with respect to any other claim in the pending application. In fact, the only claims that might be considered mutually exclusive are claims 9, 18 and 26 as they apply to claims 10, 19 and 27. However, Applicant submits that a search and examination of claims 9, 18, 26 and claims 10, 19, 27 within the same application would not pose a serious burden upon the Examiner.

Notwithstanding Applicant's comments above, in an effort to be fully responsive to the above referenced Office Action, Applicant provisionally elects to prosecute the claims readable on Figure 1. Applicant believes claims 1-8 and 20-25 are readable on Figure 1, however, Applicant reserves the right to file one or more divisional patent applications incorporating the claimed subject matter deemed to be associated with other species.

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In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application. If the Examiner has any questions regarding the present patent application, the Examiner is invited to call Applicant's attorney.

Respectfully submitted,



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